

10/083,245
Amendment and Response
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Remarks

In response to the Office Action mailed October 12, 2005 from the United States Patent and Trademark Office, claim 37 is herein amended. Support for this amendment is found in claims as originally filed. No new matter is added by the present amendment.

Claims 1, 7-12, 18-36, 38-41, 45, 46, and 51 are original or previously presented and remain pending in the present Amendment and Response. Applicants reserve the right to prosecute claims having the scope of claims as originally filed in this application, or in another application having the same priority date.

Rejection for non-statutory double patenting

The Office Action on pp. 3-4 ¶1 rejects claims 18-20, 24-27, 29-36, 40, 45, 46, and 51 under the judicially created doctrine of double patenting in view of U.S. patent number 6,372,743 ("‘743"). The Office Action on p. 4 ¶2 rejects claims 1, 7-12, 18-41, 45, 46, and 51 under the judicially created doctrine of double patenting in view of U.S. patent number 6,476,038 ("038").

The Office Action on p. 2 states that "a timely filed Terminal Disclaimer in compliance with 37 C.F.R. §1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground" Accordingly, Applicants provide here a Terminal Disclaimer for the co-owned issued patents having the following respective U.S. patent numbers: 6,372,743 and 6,476,038.

Applicants assert that upon entry of the Terminal Disclaimer attached hereto that provisional rejections under the judicially created doctrine of double patenting can properly be withdrawn, an action which is respectfully requested.

Claim 37 as amended satisfies 35 U.S.C. §112 ¶2

The Office Action on pp. 4-5 ¶3 rejects claim 37 under 35 U.S.C. §112 ¶2 as lacking antecedent basis because this claim depends on claim 28. The Examiner asserts that the claim is directed to piperidin-2-ylmethyl, which requires B and R⁵ to form a ring, and that claim 28 recites B as a —CH₂—.

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As a preliminary matter, applicants assert that the formation of the piperidin-2-ylmethyl of claim 37 is alternatively formed by joining B and R⁶.

Further, applicants herein amend claim 37 to depend directly from claim 1. Support for this amendment is found in claims 1 and 37 as originally filed. Claim 1 refers to B as an alkyl chain of 1, 2 or 3 carbons atoms, and provides that B and R⁶ can jointly form a C₃-C₆ aminocarbocycle. This amendment does not change the scope of claim 37. Thus this rejection can be withdrawn, an action which is respectfully requested.

Summary

On the basis of the foregoing amendments and reasons, Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested.

If there are any questions regarding these remarks, the Examiner is invited and encouraged to contact Applicants' representative at the telephone number provided.

Respectfully submitted,

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